

REMARKS

In the Office Action, the Examiner rejected claims 1-4 and 6-36. The Examiner objected to claim 5 and indicated that it would be allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims. By this paper, the Applicants cancel claim 33, add new claim 37, and amend claims 1-7, 11, 18, 19, 22, 23, 25, 31, 32, and 34 for clarification of certain features to expedite allowance of the present application. These amendments and the newly added claim do not add any new matter. Claims 1-32 and 34-37 are pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, the Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1, 2, 4, 6-12, and 14-36 under U.S.C. § 102(b) as anticipated by Downs (U.S. Patent No. 6,220,887). Applicants respectfully traverse this rejection.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Indeed, to

maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. See M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (C.C.P.A. 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner “must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

Claim Features Missing from the Downs Reference

Independent Claim 1 and Dependent Claims 2-10

Applicants respectfully assert that the cited reference does not teach each and every aspect of amended independent claim 1. Indeed, claim 1 is presently amended to include features of the original dependent claim 5, which the Examiner indicated as allowable. For example, claim 1 recites, *inter alia*, “a rotatable finger coupled to the mounting base via a latch.” (Emphasis added). Accordingly, Applicants respectfully assert that claim 1 is in condition for allowance.

Additionally, in view of the unique features of claim 1, as discussed above, Applicants respectfully assert that the claims depending therefrom are in condition for allowance. Further, Applicants assert that not only are the claims depending from claim 1 allowable in view of their dependency from claim 1 but also in view of unique matter recited in each dependent claim. For example, the Downs reference clearly fails to teach the recitations of dependent claim 6. Indeed, amended claim 6 recites, *inter alia*, “the rotatable finger comprises a spring separate from the support end and adapted to bias the support end against the expansion card.” (Emphasis added). The Downs reference merely teaches a series of finger levers 26 pivotally mounted to a frame 10, the finger levers 26 including bends 27. *See* Downs, col. 2, lines 62-67. The Downs reference appears to be devoid of any reference to a rotatable finger comprising a spring separate from a support end, as presently recited in claim 6. Accordingly, the Downs reference cannot anticipate the present claim 6.

For the reasons set forth above, Applicants respectfully request that the Examiner withdraw the foregoing rejections under 35 U.S.C. § 102 and allow independent claim 1 and its dependent claims.

Independent Claims 11, 18, 28, and 31 and Dependent Claims 12-17, 19-21, 29-30, 32, and 34-36

Applicants respectfully assert that the cited reference does not teach each and every aspect of independent claims 11, 18, 28, and 31. For example, amended claim 11 recites, *inter alia*, “a *tool-free* chassis mount coupled in a *cantilevered* configuration relative to a portion of the chassis adjacent the plurality of card slots.” (Emphasis added). Amended independent claim 18 recites, *inter alia*, “means for *cantilevering* to a chassis the means for configurably biasing.” (Emphasis added). Original independent claim 28 recites, *inter alia*, “a chassis mountable structure adapted for *tool-free*, *cantilevered* chassis mounting to a chassis.” (Emphasis added). Amended independent claim 31 recites, *inter alia*, “a mounting base that is *cantilevered* to the second side.” (Emphasis added).

First, Applicants respectfully assert that the Downs reference fails to teach a *cantilevered* mounting base or chassis mount. The term “cantilevered” may be defined as “A beam or member securely fixed at one end and hanging free at the other end.” *Dictionary of Engineering* 85 (Elizabeth Geller ed., 2nd ed, McGraw Hill 2003); *Dictionary of Scientific and Technical Terms* (Elizabeth Geller ed., 6th ed, McGraw Hill 2002). In contrast to a *cantilevered* mounting base or chassis mount, the

Downs reference teaches a frame 10 that spans a chassis 70 and secures to opposite sides of the chassis 70. *See* Downs, col. 2, lines 45-67 and FIG. 4. In other words, the frame 10 does not have a free end and, thus, is not cantilevered. Accordingly, Applicants assert that the Downs reference cannot anticipate independent claims 11, 18, 28, and 31.

Second, Applicants assert that the Downs reference is also deficient with respect to the recitations of a “*tool-free*” chassis mount in independent claims 11 and 28 and dependent claims 19 and 32. (Emphasis added). Similarly, the Downs reference fails to teach “*tool-free*” arm mounts or card support arms, as recited in independent claim 11 and dependent claim 35. (Emphasis added). Indeed, the Downs reference merely teaches apertures 16 in frame 10 allowing it to be secured to a chassis 70 by fasteners (e.g., threaded fasteners 44) in a manner *requiring a tool*. *See* Downs, col. 2, lines 45-61. For example, with respect to positioning levers 26, the Downs reference actually teaches that upon attaining a desired adjustment, “*a screw driver* is utilized to torque the head 48 of the fastener.” Downs, col. 3, lines 42-45 (emphasis added). This is clearly not a “*tool-free*” arm mount or card support arm. Accordingly, Applicants assert that the Downs reference cannot anticipate claims 11, 19, 28, 32, and 35.

For the reasons set forth above, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 102 and allow independent claims 11, 18, 28, and 31. Further, Applicants request that the Examiner allow the claims

depending from independent claims 11, 18, 28, and 31 based on their respective dependencies and based on unique matter recited in each dependent claim.

Independent Claims 22 and Dependent Claims 23-27

Applicants respectfully assert that the cited reference does not teach each and every aspect of independent claim 22. For example, amended claim 22 recites, *inter alia*, “a chassis comprising a first *tool-free* mounting mechanism.” (Emphasis added). Additionally, claim 22 recites “a mounting base comprising a second *tool-free* mounting mechanism, wherein the mounting base *spans less than the full distance* between first and second opposite sides of the chassis.” (Emphasis added).

First, Applicants assert that the Downs reference is deficient with respect to the recitations of first and second “*tool-free*” mounting mechanisms in claim 22. (Emphasis added). Indeed, the Downs reference merely teaches apertures 16 in frame 10 allowing the frame 10 to be secured to a chassis 70 via a tool (not tool-free). See Downs, col. 2, lines 45-61. Again, with respect to positioning levers 26, the Downs reference actually teaches that upon attaining a desired adjustment, “a *screw driver* is utilized to torque the head 48 of the fastener.” Downs, col. 3, lines 42-45 (emphasis added). This is clearly not a “*tool-free*” mounting mechanism. Accordingly, Applicants assert that the Downs reference cannot anticipate claim 22 and its dependent claims.

Second, Applicants respectfully assert that the Downs reference fails to teach “a mounting base . . . wherein the mounting base *spans less than the full distance* between first and second opposite sides of the chassis,” as recited in claim 22. (Emphasis added). In contrast, the Downs reference teaches a frame 10 that *fully spans* a chassis 70 and secures to opposite sides of the chassis 70. *See* Downs, col. 2, lines 45-67 and FIG. 4. Accordingly, Applicants assert that the Downs reference cannot anticipate independent claim 22 and its dependent claims.

For the reasons set forth above, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 102 and allow independent claim 22 and its dependent claims.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 3 and 13 under 35 U.S.C. § 103(a) as obvious over Downs (U.S. Patent No. 6,220,887) in view of Megason et al. (U.S. Patent No. 6,618,264).

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to

have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (Bd. of Pat. App. & Inter. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “well within the ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Deficiencies of Rejection

In view of the arguments set forth above with respect to the rejection of independent claims 1 and 11 under 35 U.S.C. § 102 and in view of the dependency of claims 3 and 13 from claims 1 and 11 respectively, Applicants assert that claims 3 and 13 are in condition for allowance. Indeed, as discussed above, the Downs reference fails to teach either “a rotatable finger coupled to the mounting base via a latch,” as set forth in claim 1, or “a tool-free chassis mount coupled in a cantilevered

configuration,” as recited in claim 11. The Megason reference fails to obviate the deficiencies of the Downs reference. Accordingly, the cited references considered either together or separately fail to teach each and every feature of claims 3 and 13.

Additionally, Applicants assert that the Examiner has not provided a convincing line of reason as to why one of ordinary skill in the art would attempt to combine the cited references. Indeed, the Examiner has provided no *objective evidence* of the required reason to combine. Thus, Applicants assert that the rejection of claims 3 and 13 under 35 U.S.C. § 103 was improper.

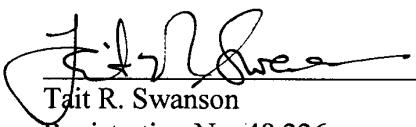
For these reasons, the Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103. Additionally, Applicants request that the Examiner provide an indication of allowance regarding dependent claims 3 and 13.

Conclusion

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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Tait R. Swanson
Registration No. 48,226
(281) 970-4545

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400